

Application No. 09/997,673
Amendment dated July 28, 2004
Reply to Office Action of March 29, 2004

REMARKS/ARGUMENTS

Responsive to the Official Action mailed October 20, 2004, applicant has further revised the claims of this case in an earnest effort to place this case in condition for allowance. Specifically, independent claim 28 has been amended. Reconsideration is respectfully requested.

Applicant wishes to thank the Examiner for his careful explanation of his position in connection with the present application. Nevertheless, applicant must respectfully refute the Examiner's rejections under 35 U.S.C. §112, and 35 U.S.C. §102 and §103. Applicant respectfully maintains that his disclosure is in full compliance with the requirements of 35 U.S.C. §112, and would be well-understood by those skilled in the art relating to non-fabric wipes and the like. Additionally, applicant must respectfully maintain that there is an undeniable absence of any recognition in the prior art of applicant's claimed invention, wherein the surface abrasiveness of one expansive surface of a nonwoven wipe is enhanced by the selective application of an adhesive binder to that one surface.

While applicant's invention is desirably straightforward in execution, the highly desirable results should not be minimized. By the straightforward expedient of selective binder application, the versatility of the present wipe product is significantly enhanced, providing a user with a product having *two distinct frictional coefficients*. There simply is *no recognition* of providing such a construct in any of the cited prior art, much less of providing a *frictional coefficient differential*, as plainly disclosed and claimed, for achieving the recited bi-functional characteristics.

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Applicant respectfully refers to M.P.E.P. Section 2163 regarding compliance with 35 U.S.C. §112. As specifically provided:

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention (citations omitted). . . . The issue raised in the cases is most often phrased as whether the original application provides "adequate support" for the claims at issue or whether the material added to the specification incorporates "new matter" in violation of 35 U.S.C. §132.

When the present application is considered in accordance with the M.P.E.P. guidelines, it is clear that applicant has fully complied with the requirements of 35 U.S.C. §112. Applicant's specification clearly explains the *frictional coefficient* obtained for the opposite expansive surfaces of the various tested samples, setting forth this frictional coefficient data in both tabular (Frictional Test Results), and graphical (Figure 4) form. There can be no doubt but that applicant's specification clearly and plainly discloses this frictional coefficient data. There is clearly no "new matter" in this regard.

In an effort to further distinguish applicant's claimed invention from the prior art, applicant has revised his claims to specify a *frictional coefficient differential*, which as previously discussed, is derived by comparing the disclosed frictional coefficients for each of the tested samples. The frictional coefficient differential for each of the tested samples is readily derived from the Frictional Test Results, and is further evident from the graphical presentation of the data in Figure 4. By specifying and claiming this *disclosed differential*, applicant *has not relied upon any new matter*.

As further provided by M.P.E.P Section 2163:

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An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention (citation omitted).

Clearly, in the present instance, applicant *has shown possession* of the claimed invention by his extensive disclosure of the frictional coefficient characteristics of the test samples, and his detailed disclosure of the testing apparatus and protocol employed to achieve this data.

M.P.E.P. Section 2163 further provides that "there is no *in haec verba* requirement", and that newly added claim limitations "must be supported in the specification through express, implicit, or inherent disclosure". Applicant must respectfully maintain there can simply be no question regarding compliance with 35 U.S.C. §112. Applicant's disclosure plainly and explicitly discloses the frictional coefficient characteristics of all of the tested samples, with the *differential characteristic* being plainly evident and "express, implicit, or inherent" by comparison of the frictional coefficient data for each of the tested samples.

Accordingly, reconsideration of this rejection is respectfully requested, and is respectfully maintained that in accordance with the requirements of M.P.E.P. Section 2163, this rejection may be withdrawn.

The Examiner has further rejected the claims under 35 U.S.C. §112, for lack of enablement. Applicant must respectfully traverse this rejection. Applicant has previously provided the Affidavit of Ms. Dianne B. Ellis, attesting to the enabling nature of the present disclosure.

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Applicant respectfully refers to M.P.E.P. Section 2163.04, which specifically provides that:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to abut the presumption (citation omitted).

The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden of presenting by a *preponderance of evidence* why a person skilled in the art would not recognize in applicant's disclosure a description of the invention defined by the claims (citation omitted).

Applicant respectfully refers to M.P.E.P Section 2164 regarding compliance with the enablement requirement of 35 U.S.C. §112. As provided:

An analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contains sufficient information regarding the subject matter of the claims is to enable one skilled in the pertinent art to make and use the claimed invention.

In M.P.E.P. Section 2164.05, it is stated that:

Applicant may submit factual affidavits under 37 C.F.R. 1.132 or cite references to shown what one skilled in the art knew at the time of filing the application a declaration or affidavit is, itself, evidence that must be considered (emphasis in original).

Under the present circumstances, reconsideration is believed to be in order. Applicant has provided *clear evidence* of compliance with the enablement requirement, and as specifically provided by the M.P.E.P. such evidence "must be considered".

In connection with the Examiner's rejection under 35 U.S.C. §112, second paragraph, it is believed that one skilled in the art will readily appreciate from applicant's disclosure how the

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cited frictional coefficient differential is measured and derived, in view of the detailed description of the manner in which the frictional coefficient for each expansive surface of the disclosed example was obtained, with the recited differential being derived by comparison of the frictional coefficient values for the tested samples.

In view of the foregoing, it is respectfully maintained that the Examiner's rejections under 35 U.S.C. §112 may be withdrawn.

In the Action, the Examiner has rejected the pending claims under 35 U.S.C. §102/103, with reliance upon U.S. Patent No. 6,103,061, to Anderson et al. Applicant has previously discussed what are believed to be the clear shortcomings in the teachings of this reference, and will therefore attempt to address the Examiner's position, as explained in the Action. The Examiner acknowledges that Anderson et al. does not "explicitly teach the limitation of a frictional coefficient differential between expansive surfaces", but goes on to assert that it is reasonable to presume that such limitations are "inherent" in the disclosure. Applicant must continue to respectfully disagree with this position.

As a careful study of the Anderson et al. reference shows, there are *no teachings whatsoever in this reference of providing meaningfully different frictional coefficient characteristics for opposite surfaces of a nonwoven wipe*. In other words, applicant must respectfully maintain that the Examiner has based this rejection on a reference which is *completely silent* regarding the claimed bi-functionality of the present nonwoven wipe.

As previously noted, the Examiner has essentially based this rejection entirely upon the vague and general language in this reference that the disclosed process include "applying a bonding material to at least one side of the web".

Applicant must respectfully refer to M.P.E.P. Section 2112, which specifically provides:

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons skilled in the art. Inherency, however, may not be established by probabilities or possibilities, the mere fact that a certain thing may result from a given set of circumstances *is not sufficient*" (emphasis supplied).

The M.P.E.P. goes on to state:

In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or in technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teachings of the applied art (citation omitted).

Applicant must respectfully maintain that his claimed bi-functional wipe, having differing frictional characteristics, as claimed, *would not necessarily follow* from the teachings of Anderson et al. To base this rejection entirely upon conjecture of what is meant by "applied to at least one side" is clearly not a determination that the allegedly inherent characteristic *necessarily flows* from the teachings of Anderson et al.

Clearly, this vague and general teaching of the Anderson et al. reference, critical to this rejection, cannot be considered in a vacuum. Rather, one skilled in the art would consider this reference to *emphasize use of friction reducing agents*, thus clearly *teaching away* from providing one surface of a wipe with enhanced abrasiveness, in accordance with the present invention.

At column 16, line 22 of Anderson et al., it is stated:

In one embodiment, the web can be calendered and then treated with a *friction reducing agent* in order to provide a resulting wiping product having a smooth, *low friction surface* (emphasis applied).

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At column 16, line 33 *et seq.*, Anderson et al. states:

Once applied to web, the *friction reducing composition* increases the smoothness of the surface of the web and *lowers friction* (emphasis applied).

At column 16, line 39 *et seq.* of Anderson et al. it is stated:

In one embodiment, the friction reducing composition applied is a quaternary lotion, such as a quaternary silicone spray.

In the Action, the Examiner has further relied upon U.S. Patent No. 4,810,568, to Buyofsky et al. Applicant must respectfully maintain that this reference does not overcome the clear deficiencies in the teachings of the principal Anderson et al. reference. Even when combined, these references do not teach or suggest applicant's claimed bi-functional wipe, and in particular, do not teach or suggest the inclusion of an intermediate layer to control migration of the abrasiveness-enhancing binder composition.

In connection with claims 26 and 27, the Examiner has further relied upon U.S. Patent No. 5,951,991, to Wagner et al. Again, this secondary reference clearly fails to overcome the deficiencies in the teachings of the principal Anderson et al. reference, and moreover, *does not teach providing a wipe with differing coloring on the expansive surfaces to differentiate differing levels of abrasiveness*. This is simply not taught or suggested by any of the art of record. When there is no such teaching in any of the references, their combined teachings cannot provide a proper basis for rejection under 35 U.S.C. §103 (see M.P.E.P. Section 2143.03, which specifically provides "to establish *prima facie* obviousness of a claimed invention, *all the claim limitations must be taught or suggested by the prior art*" (citations omitted)).

In the Action, the Examiner has further rejected the pending claims under 35 U.S.C. §103, with continued reliance upon U.S. Patent No. 6,022,818, to Welch et al., in view of U.S.

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Patent No. 5,213,588, to Wong et al. The shortcomings in the teachings of these references in suggesting the present invention have been previously discussed, but are respectfully emphasized. The principal Welch et al. reference *is not* concerned with providing a bi-functional wipe, having differing abrasive characteristics, but rather concerns "a fluid management component in personal care absorbent articles such as diapers, training pants, incontinence products, feminine hygiene products, bandages, wipes and the like" (column 1, lines 17-20). Clearly, *fluid management* is the principal thrust of the disclosed material.

As will be recognized by those familiar with the art, creating *differing abrasive characteristics* is ordinarily not considered when providing a "fluid management component" in a personal care absorbent article such as a diaper or the like.

The Examiner acknowledges that "Welch et al. do not teach applying an abrasive coating to the fabric for cleansing purposes". Applicant must respectfully maintain that in light of such acknowledged deficiencies in the teachings of this reference, it appears to be very inappropriate to rely upon this as the principal reference in a rejection under 35 U.S.C. §103. In essence, it is acknowledged that *Welch et al. fails to teach or suggest the principal feature of the presently claimed invention.*

The Examiner has relied upon the secondary Wong et al. reference for its teachings relating to the addition of abrasive particles to a nonwoven wiping material. Again, it is acknowledged that Wong et al. *fails to teach creating differing abrasive levels for opposite surfaces of a wipe.*

Thus, the principal Welch et al. reference is acknowledged as failing to teach application of an adhesive coating for enhancing abrasiveness, and does not otherwise teach

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creating differing abrasiveness levels. The Wong et al. reference is acknowledged as failing to teach creating *differing abrasiveness levels*.

Accordingly, applicant must respectfully request reconsideration of this rejection, since even when combined, these references clearly fail to teach or suggest applicant's novel, bi-functional wiping product, as claimed.

Again, applicant wishes to thank the Examiner for his careful explanation of his position, and his thorough discussion of applicant's previous arguments. Nevertheless, it is respectfully maintained that the presently pending claims are fully in compliance with the requirements of 35 U.S.C. §102, §103, and §112, and accordingly, formal allowance of claims 22-28 is believed to be in order and is respectfully solicited. Should the Examiner wish to speak with applicant's attorneys, they may be reached at the number indicated below.

The Commissioner is hereby authorized to charge any additional fees which may be required in connection with this submission to Deposit Account No. 23-0785.

Respectfully submitted,

By 
Stephen D. Geimer, Reg. No. 28,846

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 West Madison Street, Suite 3800
Chicago, Illinois 60661-2511
312/876-1800